

### REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 1-14 were pending with claims 7-13 withdrawn from consideration following a Restriction Requirement. By the present response, claims 7-13 have been canceled without prejudice or disclaimer. Thus, upon entry of the present response, claims 1-6 and 14 remain pending and await further consideration on the merits.

Entry of the forgoing is appropriate pursuant to 37 C.F.R. §1.116 for at least the following reasons. First, the amendments address the new grounds of rejection under 35 U.S.C. §§102 and 103. Second, the amendments raise no new issues that would necessitate further search and/or substantive reexamination and reduce the number of claims pending in the application by canceling the non-elected claims.

### **REQUEST TO WITHDRAW FINALITY OF OFFICIAL ACTION**

It is respectfully requested that the finality of the Official Action dated July 6, 2004, be withdrawn.

MPEP §706.07(a) sets out the standard for when a final rejection is proper on a second or subsequent action. MPEP §706.07(a) states that:

shall be final, ***except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement*** filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).  
(emphasis added)

Here, the Examiner has introduced new references (the *Kleinhen* patent and the *Ferag* patent) and alleges Applicant's amendment necessitated the new grounds for rejection. However, Applicant has not made any such amendment. The most recent submission by the Applicant (dated June 1, 2004) contained a single amendment to the claims to change "the" to "a." Clearly this type of amendment does not constitute sufficient grounds on its own to overcome the prior reference and does not rise to the standard articulated in the MPEP.

It is respectfully asserted that the prior response removing the then relied upon Trovinger reference as prior art is the reason the Examiner had to introduce the new references. This is supported by the language at page 2 of the Official Action. Namely:

*In view of applicant's arguments* filed on 06/01/2004 and upon further consideration the final rejection filed on paper #10 is withdrawn and new final rejection applied as shown in this action. (emphasis added)

From the above, it is respectfully asserted that no proper basis for issuing a Final Office Action exists in this case and the finality of the Official Action is premature. See MPEP §706.07(a) and §706.07(c). Accordingly, withdrawal of the finality of the Official Action dated July 6, 2004, is respectfully requested.

#### ***CLAIM REJECTIONS UNDER 35 U.S.C. §102***

Claims 1-4 and 14 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,615,871 to Kleinhen (hereafter "*Kleinhen*") on the grounds set forth on page 2 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

Exemplary embodiments of the present invention are directed to a system for handling folded sheet material. In the exemplary Figure 1A embodiment, a rotatable clamping device 104 is illustrated which includes a linearly displaceable clamping component 106 and a fixed clamping component 108. As described in paragraph [0011] on page 5 of the specification, the rotatable clamping device is configured to simultaneously encompass opposing sides of a collecting device. This paragraph describes that in at least one stage of a sheet delivery operation, clamping components of the rotatable clamping device are positioned such that they exert force against opposing sides of a collecting device (such as collecting device 102) at the same time. Paragraph [0012] on page 5 of the specification describes that, with respect to the Figure 1G example, rotatable clamping device 104 is arranged such that its displaceable clamping device 106 and its fixed clamping component 108 are positioned on, and are able to press against, different and opposing sides of collecting device 102 at the same time. This paragraph describes that such a feature secures sheet material 124 against opposing sides 126 and 128 of collecting device 102. The clamping function is also shown in the side view of Figure 2, where sheet material 224 is secured on opposite sides of collecting device 202 simultaneously by displaceable clamping component 206 and fixed clamping component 208 of a rotatable clamping device.

Such features are broadly encompassed by the independent claims 1 and 14. For example, claim 1 is directed to a system for handling folded sheet material which includes, among other features, a rotatable clamping device having a linearly displaceable clamping component and a collecting device shaped substantially as a

saddle. Claim 1 also recites that the rotatable clamping device is configured to simultaneously press against opposing sides of the collecting device.

Claim 14 is directed to a system for handling a folded sheet material. Claim 14 recites, among other features, a rotatable clamping device having a linearly displaceable clamping component. Claim 14 also recites displaceable and fixed clamping components which press different portions of folded sheet material against opposing sides of a collecting device simultaneously.

The rejection of these independent claims based on the disclosure in *Kleinhen* is improper because *Kleinhen* does not disclose each and every element of the present independent claims.

*Kleinhen* discloses a sheet material handling apparatus with a sheet material handling assembly 44 that rotates (see Fig. 5 arrow indicating rotation direction and column 4, lines 5-7) to pull sheet material article 14 from hopper 42, fold sheet material article 14 by folder assembly 106. After being folded and creased, the sheet material article 14 is directly transferred to the collator conveyor 22 (see column 7, lines 9-11).

The Examiner has identified the rotatable clamping device as "rotating conveyor 22" (see page 2 of the Official Action). Applicant respectfully disagrees. There is simply no disclosure in *Kleinhen* that the collator conveyor 22 is rotatable. Rather, it is sheet material handling assembly 44 that rotates in *Kleinhen* and not collator conveyor 22. Thus, the rejection has failed to identify any element of *Kleinhen* that corresponds to the rotatable clamping device as claimed.

However, even if, *arguendo*, one does consider the identified conveyor 22 as rotating, all of the elements of the present claims are not disclosed in *Kleinhen*. For

example, with conveyor 22 identified as the rotatable clamping device, which element of the *Kleinhen* device is the claimed collecting device shaped substantially as a saddle? The Official Action identifies the same element of *Kleinhen*, e.g., the conveyor apparatus 22, as the claimed collecting device. Clearly, the single conveyor apparatus cannot be applied against the two distinctly claimed elements of the rotatable clamping device and a collecting device shaped substantially as a saddle. For at least this further reason the rejection is improper and should be withdrawn.

In addition, if one accepts that the identified conveyor 22 rotates (which applicant does not), then which elements of the rotatable collecting device are configured to simultaneously press against opposing sides of the collecting device (claim 1). The Official Action has identified pusher 26 as this feature, but correlating pusher 26 as this feature suffers from the same inconsistencies discussed above with respect to the rotatable clamping device and the collecting device. In addition and with respect to claim 14, there is no disclosure in *Kleinhen* that pusher 26 has both a fixed clamping component and a displaceable clamping component as recited in claim 14. Clarification and/or withdrawal of this rejection are respectfully requested.

Finally, even if one considers the sheet material handling assembly 44 disclosed in *Kleinhen* as the rotatable clamping device and the collator conveyor 22 can be a saddle-type collator conveyor (column 3, lines 31-32), the disclosure in *Kleinhen* still does not contain each and every claimed element. In this case, the sheet material handling assembly 44, e.g., the rotatable clamping device, does not simultaneously press against opposing sides of the collecting device as recited in

claim 1 nor does the sheet material handling assembly 44 of *Kleinhen* include a linearly displaceable clamping component and a fixed clamping component, wherein the displaceable and fixed clamping components press different portions of the folded sheet material against opposing sides of the collecting device simultaneously as recited in claim 14. In fact, no component of the sheet material handling assembly 44 contacts the conveyor apparatus 22, e.g., the claimed collecting device. Thus, even in this interpretation of *Kleinhen*, the *Kleinhen* reference does not include each and every element of the independent claims.

In light of at least the above identified differences between the claims and the disclosure in *Kleinhen*, Applicant respectfully submits that an anticipatory rejection is improper since *Kleinhen* does not disclose the invention as claimed. Further, the rejection is improper as an anticipatory rejection for at least the above noted reasons. Accordingly, the rejections should be withdrawn.

The remaining dependent claims are improperly rejected as anticipated by the disclosure in *Kleinhen* for at least the same reasons as discussed above.

Withdrawal of the rejections is respectfully requested.

### **CLAIM REJECTIONS UNDER 35 U.S.C. §103**

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Kleinhen* on the grounds set forth on page 3 of the Official Action. This rejection relies upon the pusher 26 of *Kleinhen* being correlated to the displaceable clamping component and is this improper and should be withdrawn for at least the same reasons as outlined above with respect to claim 1.

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Kleinhen* in view of EP 399 317 to Ferag (hereafter "*Ferag*") on the grounds set forth on page 3 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

The Official Action properly notes that *Kleinhen* does not disclose a collecting device pivotable to move a supporting edge of the collecting device relative to the rotatable clamping device. However, the reliance upon the disclosure in *Ferag* is misplaced, as that reference also does not disclose such an arrangement or feature.

Figs. 18-25 and element 10 of *Ferag* referenced by the Examiner are not pivotable relative to a rotatable clamping device. Rather, element 10 of *Ferag* includes a plurality of stations 14 that are stationarily mounted to a rotating device (see Fig. 1) that rotates (not pivots) (direction U) about axis 12. The stations 14 aligned below a stapler head for stapling of sheets 20.

There is simply no disclosure in the referenced figures as to element 10 pivoting as alleged by the Examiner. Accordingly, the identified disclosure in *Ferag* cannot properly be the basis for an obviousness rejection because all of the elements of a *prima facie* case of obviousness have not been established. Mainly, the present rejection is improper because the cited references do not teach or suggest all of the claim limitations. See MPEP § 2143. Accordingly, the rejection is improper and should be withdrawn.

**CONCLUSION**

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

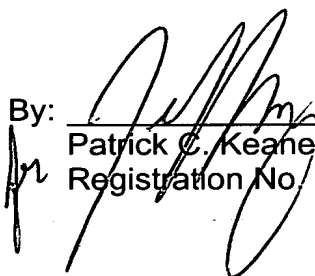

Respectfully submitted,

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